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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/726,024	10/04/1996	DANIEL A. HENDERSON	317MH-23513	8599

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06/06/2005

EXAMINER

WEAVER, SCOTT LOUIS

ART UNIT	PAPER NUMBER
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2645

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/726,024	Applicant(s) HENDERSON, DANIEL A.	
	Examiner Scott L. Weaver	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 157-191 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 157-191 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 04 October 1996 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/6/03 and 3/2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2645

1. Applicant's arguments filed 9/28/2004 with respect to claims 157-191 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are not legible. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 157-191 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 157 is confusing with respect to reference of 'shift keyed data' (ln. 9) in combination with claim 163 wherein the caller identification data is being supplied (and received by the answering apparatus in claim 157) from an ISDN connection, it is not clear where this is described in combination as presented or what "shift keyed data" is definitely intended to mean with respect to this combination of limitations. It is not clear if 'shift keyed' as used in claim 157 is intended to refer to something other than merely FSK data as it is used in claim 162, the phrase 'shift keyed' is not seen in the original specification.

Art Unit: 2645

Claims 190 and 191 cause confusion and may be inaccurate of the originally disclosed invention in combination with claim 157, the specification does not clearly refer to a telephone answering apparatus performing the steps of claim 157 in conjunction with a message center as in claims 190 and 191, in contrast, the specification refers to a message center device (301) which may "be" a conventional telephone answering device, it does not refer to two separate devices as claimed in claims 190 and 191. Further, it is not clear as to the proper description of the message center in claims 190 and 191 having storage in contiguous or non-contiguous manner as claimed.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 157-167, 175-176, and 186-187 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Duncan et al. (#5,502,761).

Duncan teaches as pertains to claim 157, method for communicating calling party information to called party answering apparatus, the calling party information received from telephone network via ANI or CPID (col.2,ln.22-27), the called party answering apparatus which is reached via the telephone network includes a "Call Information Relay Device" (CIRD) which enables the called party to receive a page (inherently through connection to the pagers' paging network) which includes the calling party information transmitted through the telephone network

Art Unit: 2645

by dialing telephone number from the called party answering apparatus. The pager is a portable communication device and is pageable by the paging network which manages its subscription. Both analog and digital incoming telephone lines are shown as pertains to receiving FSK data using the caller party ID and ISDN data in the digital embodiment (see Abstract; figures 1-3; col.4,ln.7-18; col.4,ln.35-50; col.5,ln.50-54).

With respect to claim 158, the answering apparatus is connected in figure 2-3 to the telephone network with numerals 14,15 and 28,29 respectively referring to first and second telephone lines in the analog and digital form respectively, the CIRD is responsible for dialing the paging apparatus through the paging network using one of the telephone lines and thus is connected to the paging network with a direct connection (col.5,ln.6-18; col.5,ln.36-48).

With respect to claim 159, the caller identification data is transmitted by dialing a telephone number and thus is transmitted over the telephone network to the paging network (col.5,ln.10-12).

With respect to claim 160, the caller identification includes numeric data (as per known definition of ANI and caller ID).

With respect to claim 161, Duncan teaches use of calling party ID which includes alphanumeric (name data) as per known definition of ANI and caller ID.

With respect to claim 162, Duncan uses ANI or calling party ID (col.2,ln.22-27) in analog form via figure 2 embodiment which uses FSK for signaling of the identifying information from the telephone network.

With respect to claim 163, Duncan teaches supplying the caller identifying information from ISDN connection in the digital embodiment (figure 3; col.5,ln.50-col.6,ln.57).

Art Unit: 2645

With respect to claim 164, Duncan teaches use of ‘the appropriate code format’ to transmit the recorded caller identification to the paging network (col.5,ln. 9-18).

With respect to claim 165, Duncan teaches caller verifying identifying information before transmission (figure 1, 110; col.3,ln.36-47).

With respect to claims 166 and 167, Duncan teaches the user can enter optional data (such as a different number or voice data) prior to transmission of the identifying data to the paging network (col.3,ln.40-42; col.4,ln. 49-51).

With respect to claim 175, Duncan teaches the CIRD initiating call to paging network after receiving the caller identification data (col.5,ln.9-18).

With respect to claim 176, Duncan teaches each embodiment includes two telephone lines, the figure 1 does not show the caller being disconnected before the calling information is relayed to the pager therefore the transmitting to the paging network occurs before the caller hangs up.

With respect to claim 186, the pager of Duncan is a portable computing device (in as far as such is defined in the claim it is required to have radio communications ability) having radio communications abilities.

With respect to claim 187, in as far as the phrase “personal digital assistant “ is defined in the claim, Duncan teaches the pager is a personal digital assistant as it enables the called party to be assisted by showing calling information intended for the pagers user which is personal information. Alternatively, with respect to claims 186 and 187, the use of pagers in computer type devices (such as those which provide other programs than merely pager communications) are notoriously well known in the art, see the cited May patent for example.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 168 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan as applied to claim 157, 166 and 167 above, in view of Parvelescu et al. (#6,002,719). (note this reference is used because it is believed that this subject matter is not of record in the provisional application).

Duncan does not teach compressing the optional data prior to receiving at the portable terminal.

Parvelescu, among others, teaches known use of compression of message to be stored and transmitted in order to save amount of storage space as well as maximize bandwidth utilization by minimizing transmission times (abstract; figure 2; col.1,ln. 7-12; col.1,ln.40-43; col.1,ln.51-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Duncan to compress data as taught by Parvelescu in a message which was to be sent in the system of Duncan in order to maximize bandwidth utilization.

9. Claims 169 and 185 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan as applied above in view of Owen (#5,483,595).

Art Unit: 2645

Duncan does not teach the optional data is encrypted before being received at the portable terminal as pertains to claim 169 nor the requirement of password to receive message as epr claim 185.

Owen, among many others, teaches encrypting pager messages before being received at a portable paging device such as to ensure security of the message being sent . Owen further teaches recipient of message being required to input password to receive message (Figure 3,4, 6, 7,; col.6,ln.46-col.7,ln.7)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Duncan to encrypt the message before being received by the pager as taught by Owen in order to ensure that the message being sent was secure and enabling the user of the paging device of Duncan to maintain confidentiality of messages sent without enabling others to eavesdrop by intercepting the messages or enable a nonauthorized user without a password to access the messages when such device was not in the proper persons possession. (Owen ; col. 1,ln.33-39).

10. Claim 170 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan as applied above in view of Nelson 4,885,577.

Duncan does not teach the optional data comprised of voice message is transmitted to the portable device with the caller identification data as pertains to claim 170.

Nelson teaches transmitting both caller identification data and voice message to the pager simultaneously (abstract; col.2,ln.55-62; col.5,ln.42-62) such that the sending of the combination of voice message and caller identification is extremely useful to a user by providing a record of

Art Unit: 2645

essential data including the telephone number , as well as allowing recognition of the sender's voice to help determine urgency of the message.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Duncan to send both voice message and caller identification as taught by Nelson for the purpose of enabling the user to have a record of telephone number and determine urgency of message by listening to the senders voice message.

11. Claim 171 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan as modified in view of Nelson as applied to claim 170 above, and further in view of Parvelescu.

Duncan as modified in view of Nelson does not teach compressing the optional data prior to receiving at the portable terminal.

Parvelescu, among others, teaches known use of compression of message to be stored and transmitted in order to save amount of storage space as well as maximize bandwidth utilization by minimizing transmission times (abstract; figure 2; col.1,ln. 7-12; col.1,ln.40-43; col.1,ln.51-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Duncan as modified in view of Nelson to compress data as taught by Parvelescu in a message which was to be sent in the system as modified by the references in order to maximize bandwidth utilization.

Art Unit: 2645

12. Claims 172 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan in view of Nelson as applied to claim 170 above, and further in view of Owen.

Duncan as modified in view of Nelson does not teach the optional data is encrypted before being received at the portable terminal.

Owen, among many others, teaches encrypting pager messages before being received at a portable paging device such as to ensure security of the message being sent (.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Duncan as modified in view of Nelson to encrypt the message before being received by the pager as taught by Owen in order to ensure that the message being sent was secure and enabling the user of the paging device of Duncan modified in view of Nelson to maintain confidentiality of messages sent without enabling others to eavesdrop by intercepting the messages (Owen ; col. 1,ln.33-39).

13. Claims 173-174 and 190-191 (as best understood due to the confusion noted above) are rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan in view of De Luigi et al. (#5,418,529).

Duncan is silent on the particular storage in contiguous memory locations as per claim 173, 190 and storing in non-contiguous memory locations as per claim 174, 191

De Luigi teaches the benefits of storing data in memory locations which are either contiguous or non-contiguous (figure 2; col.2,ln.58-col.3,ln.19) .

It would have been obvious to one of ordinary skill in the art to modify Duncan to include memory management technique as taught by De Luigi with contiguous and non-

Art Unit: 2645

contiguous storage of information for purpose of manipulating message within the memory arrangement, removing limits imposed on the processor as well as for reducing storage requirements (col.3,ln.3-19). The message receiving device is considered a message center.

14. Claims 179-182, and 189 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan in view of Gao (WO 9408421 A1).

Duncan does not teach to annunciate the caller ID at the portable device, as per claim 179, simultaneously display number as per claim 180, and store caller data and initiate new connection as per claim 181, nor initiate the connection over a cellular network.

Gao teaches to annunciate the caller identification using voice synthesizer (as applies to claim 189) to annunciate the telephone number received with display shown in the figure for use as a known pager device including such as display of Duncan with Gao further teaching generation of audio tones for use in dialing the telephone number (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made modify the device of Duncan such as to enable the user to hear the caller ID as well as see the message as taught by Gao for the reason of enabling the user to be alerted to caller when visual capabilities were compromised such as while driving. It would also have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Duncan to include the capability of generating the number for dialing as taught by Gao for the purpose of enabling one touch callback dialing, which also would be beneficial to the user of such device while driving with use of cellular device and cellular network while driving a necessary feature of communications with telecommunications networks in mobile vehicles.

Art Unit: 2645

15. Claims 177-178 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan in view of Davis (#4,942,598).

Duncan does not teach to compare the caller ID in the answering apparatus with selective forwarding of the caller identification as per claim 177 nor as per claim 178 transmitting if an entry matches in the memory.

Davis teaches forwarding of caller identifying data to paging network only if the operational data corresponding thereto instructs the answering apparatus to do so. (Figure 3A, 3B; col.2,ln.50-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Duncan to compare the caller ID before transferring such to the pager as taught by Davis for the purpose of eliminating in order to limit the amount of memory usage at the pager device (col.1,ln.60-col.2,ln.3 Davis).

16. Claims 182-184 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan in view of Wohl et al. (#5,247,700)

Duncan does not teach use of combined cellular telephone with pager with use of cellular network and ability to redial incoming number

Wohl teaches combined cellular telephone with pager which utilizes the cellular network (abstract) with use of cellular network advantageous for location processing of devices eliminating scanning and serving to conserve energy (col.1,ln.55-col.2,ln.2)

Art Unit: 2645

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Duncan to include a combined cell phone and pager which uses the cellular network as taught by Wohl for the purpose of enabling the device to be used to dial received telephone numbers while in a mobile location such as a vehicle while eliminating requirement for pager to scan for location purposes.

17. Claim 188 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan as applied above in view of May (#5,043,721).

Duncan does not state the pager is a two way communication device.

May teaches portable pager device which is capable of two way communications (col.5,ln.58-65; col.6,ln.51-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Duncan to include two way communication capabilities as taught by May for the purpose of enabling the page receiving user to send messages form the page receiving device.

Conclusion

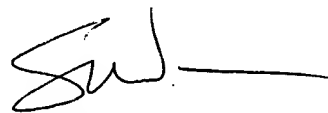
18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The applicants prior art did not include the non-patent literature listed on either PTO form 1449 form submitted by applicant and as such the noted references have not been considered by the examiner.

Art Unit: 2645

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is 571-272-7548. The examiner can normally be reached on Monday to Friday 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SCOTT L. WEAVER
PRIMARY EXAMINER

Art Unit 2645